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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,382	06/11/2001	David Stoloff	J&J-0102/GYN-082	3839

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EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,382

Applicant(s)

STOLOFF ET AL.

Examiner

HUNG Q PHAM

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 15-21, drawn to a method and system for categorizing an unmet need relating to medical products from a plurality of users, classified in class 707, subclass 7.
- II. Claim 11-14, drawn to a method and program for presenting a form for inputting an unmet need by using a plurality of fields, classified in class 715, subclass 507.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as facilitating the input of an unmet need by presenting a form with a plurality of fields. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2162

During a telephone conversation with Applicants' representative, MICHAEL J. SWOPE, on 03/16/2005, a provisional election was made without traverse to prosecute the invention of group I, claims 10-10 and 15-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-14 were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 5 is objected to because of the following informalities: a unmet need.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (IV) (B) (2) (a):

Products may be either machines, manufactures, or compositions of matter.

Art Unit: 2162

A machine is "a concrete thing, consisting of parts or of certain devices and combinations of devices." Burr v. Duryee, 68 U.S. (1 Wall.) 531, 570 (1863).

.....

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., Lowry, 32 F.3d at 1583, 32 USPQ2d at 1034-35; Warmerdam, 33 F.3d at 1361-62, 31 USPQ2d at 1760.

The claimed *complaints* of claim 18 as defined in the specification, page 12, is information, and not a part or certain device of the system a category. Therefore, the claim is non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As in claim 1,

Art Unit: 2162

the clause *where a predetermined number of unmet need submissions have the same primary topic* references to some other items in the claim, but it is unclear what item is being referenced to;

those unmet needs of the step of selecting references to some other items in the claim, but it is unclear what item is being referenced to.

As in claims 3,

the limitation *the selecting of unmet needs having a predetermined number of unmet need submissions* is recited, and there is insufficient antecedent basis for this limitation in the claim;

the clause *the unmet needs* in the step of filtering references to some other items in the claim, but it is unclear what item is being referenced to.

As in claim 15, the clause *where a predetermined number of unmet need submissions have the same primary topic* references to some other items in the claim, but it is unclear what item is being referenced to.

As in claim 17, the limitation *the selecting of unmet needs having a predetermined number of unmet need submissions* is recited, and there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4, 7-10, 15, 16, 18 and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by drugstore.com [drugstore.com – online pharmacy & drugstore, prescriptions filled].

Regarding claims 1 and 15, drugstore.com is a computer system implements a method for collecting medical product information, comprising:

providing a web site having information about medical products (drugstore.com, pages 1-2);

accepting on said web site input indicative of an unmet need relating to the medical products from a plurality of users (a plurality of users can input a medical request that are not currently addressed by available medical products in the question form, e.g., *Does fish oil help lower cholesterol?* as indicated at page 4 into SEARCH OUR Q&As box of page 4, or ASK YOUR PHARMACIST at page 3. The question as unmet need is accepted by the website via a SUBMIT QUESTION button);

Art Unit: 2162

categorizing the unmet need according to a primary topic (the question or unmet need could be categorized into particular topic, e.g., ARTHRITIS, OSTEOARTHRITIS... as illustrated at page 4);

selecting those unmet needs for development where a predetermined number of unmet need submissions have the same primary topic (only those submitted questions with the same primary topic, e.g., OSTEOARTHRITIS in *How can I get relief from my osteoarthritis* of page 4, which have already been answered at least once by pharmacists, will be selected for processing to make available answer to the user. One is the predetermined number in order to have an available answer. Otherwise, ASK YOUR PHARMACIST is used to have an email response).

Regarding claims 2 and 16, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, drugstore.com further discloses *the categorization is done performed by each said plurality of users electronically selecting a category* (page 4).

Regarding claim 4, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claim 1, drugstore.com further discloses the step of *providing a gatekeeper such that the gatekeeper filters out input that relates to product complaints* (page 9).

Art Unit: 2162

Regarding claims 7 and 21, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, drugstore.com further discloses the step of *providing a computer implemented medical products information web site in conjunction with the unmet needs input such that users can input unmet needs while obtaining medical products information* (page 4).

Regarding claim 8, pages 1-10 are created by a computer process, and these imply *a computer-readable medium bearing computer readable instructions for carrying out the steps recited in claim 1.*

Regarding claim 9, drugstore.com is a web site for collecting medical product information, comprising:

a web site wherein the web site stores information about medical products, information about the medical products being electronically searchable and browseable (pages 1 and 2), and *a computer that hosts the web site* is an inherent feature of pages 1 and 2;

a network connection (WWW) whereby web pages are delivered to a remote computer and input is accepted from the remote computer (any computer that has access to the WWW can retrieve an exist web page by inputting an URL), *the network accepting an electronic submission indicative of an unmet need for the medical products* (a plurality of users can input a medical request that are not currently addressed by available medical products in the question form, e.g., *Does fish oil help lower cholesterol?* as indicated at page 4 into SEARCH OUR Q&As box of pate 4, or ASK YOUR PHARMACIST at page 3. The

Art Unit: 2162

question as unmet need is accepted by the website via a SUBMIT QUESTION button) *whereby unmet needs related to the medical products may be determined* (those submitted questions with the same primary topic, e.g., OSTEOARTHRITIS in *How can I get relief from my osteoarthritis* of page 4, which have already been answered at least once by pharmacists, will be selected for processing to make available answer to the user).

Regarding claim 10, drugstore.com further comprising *a medical products purchasing database whereby a user can purchase medical products in conjunction with the submission of an unmet need submission* (page 2).

Regarding claim 18, drugstore.com further comprising *complaints* (page 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 5, 6, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over drugstore.com [drugstore.com – online pharmacy & drugstore, prescriptions filled] in view of Wang et al. [USP 6,766,320 B1].

Regarding claims 3 and 17, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, drugstore.com further discloses the step of *selecting of unmet needs having a predetermined number of unmet need submissions* (only those submitted questions with the same primary topic, e.g., OSTEOARTHRITIS in *How can I get relief from my osteoarthritis* of page 4, which have already been answered at least once by pharmacists, will be selected for processing to make available answer to the user). But does not explicitly teach the step of *filtering the unmet needs*. Wang teaches a search engine to match a question to a set of frequently asked questions stored in a database (Wang, Abstract). Wang further discloses the step of filtering the question (Wang, Col. 8, Lines 40-64). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the drugstore.com technique by including the step of filtering noisy words from

an unmet need, e.g., *How can I get relief from my osteoarthritis* of page 4, in order to produce keywords for searching.

Regarding claims 5 and 19, drugstore.com teaches all of the claimed subject matter as discussed above with respect to claims 1 and 15, but does not explicitly teach the step of *providing a gatekeeper such that the gatekeeper filters out input that describes a unmet need and a solution to the unmet need*. Wang teaches a search engine to match a question to a set of frequently asked questions stored in a database (Wang, Abstract). Wang further discloses the step of providing a gatekeeper such that the gatekeeper filters out input that describes a unmet need (Wang, Col. 8, Lines 40-64), and a solution to the unmet need (Wang, Col. 11, Line 10-Col. 12, Line 11). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the drugstore.com technique by including the technique of filtering out unmet need and solution as taught by Wang in order to produce key words for searching and matching with the best answer.

Regarding claims 6 and 20, drugstore.com and Wang, in combination, teach all of the claimed subject matter as discussed above with respect to claims 5 and 19, drugstore.com further discloses *an invention submission disclosure form is transmitted to the user that submitted the unmet need (page 4) and the solution to the unmet need (page 6)*.

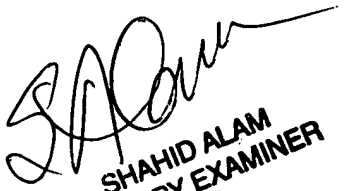
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
March 17, 2005


SHAHID ALAM
PRIMARY EXAMINER